

"cached," if the connection between the playback device and the remote device is not available during playback. The information stored in the database may be used to select complementary content that is likely to be of interest to the user listening to the recording. For example, if the recording is a compact disc containing a compilation of a number of artists and the user repeatedly listens to a specific track, the server may send information regarding other recordings by the same artist that produced that track.

#### The Prior Art

##### U.S. Patent 5,963,916 to Kaplan

The Kaplan patent is directed to a system for supplying music products for preview by customers and for compiling market data. The first embodiment disclosed in Kaplan is a system for distributing music to kiosks, which might be located in a store. The second embodiment supplies the music products over the Internet to customers' homes. All of the embodiments disclosed in Kaplan appear to have the purpose of convincing the users of the system to purchase full recordings that contain the audio or video program material transmitted from the server to the user devices and detecting what types of music products customers are considering buying and actually do purchase.

##### U.S. Patent 5,710,884 to Dedrick

The Dedrick patent is directed to a system for automatically updating a personal profile server with additional user information gathered from monitoring use of a computer.

#### Rejection under 35 U.S. C. § 102(e)

In item 4 on pages 2-3 of the Office Action, claims 2, 3, 5, 6, 11-45, 47-57 and 60-62 were rejected under 35 U.S.C. § 102(e) as anticipated by Kaplan. As discussed above, Kaplan is directed to a system for selling audio or video programs and monitoring the sales process, while the present invention is directed to monitoring what happens when a recording that has already been purchased is played. The present invention distinguishes over the prior art in several ways. The independent claims have been amended to emphasize these differences. For example, claims 2 and 41 have been amended to require that use data is collected "regardless

of whether the first and second devices are connected" (claims 2 and 41, lines 4-5) and to recite "establishing a connection between the first and second devices after the recording has been obtained" (claims 2 and 41, lines 6-7). Since the objective of the system disclosed in Kaplan is to provide the audio or video program material via a network, the connection is established first and is maintained throughout use of the system by a user.

Another way of understanding the differences between the present invention and the system taught by Kaplan is that according to the present invention, the recording is "fixed in a medium owned by a user" (claim 43, lines 3-4 and claim 62, line 3). Since the purpose of the system taught by Kaplan is to sell the recording, the system disclosed by Kaplan does not operate in the manner recited in claims 43 and 62.

Furthermore, the system disclosed by Kaplan merely sends out a sample of an audio or video program in response to a selection by a user. The present invention, on the other hand, is commonly used with recordings, such as compact discs, that have multiple tracks or segments. One of the features of the present invention is the ability to detect the segment to which a user is listening and transmitting information regarding how often and how much of the segment was played. Thus, claim 22 recites "collecting use data associated with the recording, including segment data identifying the at least one segment played" (claim 22, lines 6-7). For the above reasons, it is submitted that all of the independent claims, 2, 22, 41, 43, as well as all of the claims dependent therefrom patentably distinguish over Kaplan.

Additional distinctions are recited in some of the dependent claims that were rejected under 35 U.S.C. § 102(e). For example, claim 18 recites "supplying complementary content for the recording to the first device via the network" (claim 5, lines 1-2). It was asserted at page 3, line 7 of the Office Action that Kaplan discloses providing "complimentary data" at column 16, lines 6-18. However, everything in this portion of Kaplan suggests that the data or content that is supplied is based on what is likely to be of interest to the user. No suggestion of supplying information that is "complementary ... for the recording" has been found in this or any other portion of Kaplan. Since claims 18, 35, 46 and 68 recite a similar limitation, it is submitted that claims 5, 18, 35, 46 and 68 further patentably distinguish over Kaplan for this additional reason.

Claims 6, 19, 37, 47, 56 and 70 further emphasize the distinction noted in the preceding paragraph by reciting that the complementary content is selected "based on the use data" (e.g., claim 6, line 2) as well as the user demographic data. As discussed above, no suggestion has been found in Kaplan of selecting the complementary data based on use data that is, e.g., "related to at least one of a portion of the recording and play time of the recording" (lines 1-2 of claim 3 from which claim 6 depends) or "information regarding playing of at least one portion of the recording" (lines 2-3 of claim 45 from which claim 47 depends). Therefore, it is submitted that claims 6, 19, 37, 47, 56 and 70 further patentably distinguish over Kaplan.

#### Rejection under 35 U.S.C. § 103

In item 7 on page 4 of the Office Action, claims 7-15, 20, 21, 23-26, 29, 30, 39, 40, 42, 48-53, 58-61 and 64 were rejected under 35 U.S.C. § 103 as unpatentable over Kaplan in view of Dedrick. Item 7 asserted that it would be obvious to apply the teachings in Dedrick to the system taught by Kaplan, "because it would have enabled the host to compile a more complete user profile for use by advertisers" (Office Action, page 4, lines 15-17). However, the distinctions noted above between the present invention and Kaplan involve the recording: where it is located, how the use data is obtained, what is included in the use data, etc. None of these deficiencies of Kaplan are overcome by adding Dedrick. Specifically, as noted above Dedrick does not teach or suggest sending from a first device to a second device "information regarding playing of at least one portion of the recording" as recited in claim 45, or any of the similar limitations in the other independent claims. Having such information available to the user(s) of the second device provides the benefit of much more accurate information about how user(s) of the first device listen to the recording than is provided by any conventional method.

Since all of the claims rejected under § 103 are dependent from claims that depend from one or more of the claims discussed above, it is submitted that all of the claims, including those rejected under § 103, patentably distinguish over Kaplan in view of Dedrick for the reasons discussed above.

#### Other Cited Art

U.S. Patent 5,949,411 to Doerr et al. (Reference B) was cited in the Office Action, but was not used to reject the claims. As recognized by the Examiner, Doerr et al. does not teach or suggest the present claimed invention, but rather is directed to a system for a multimedia preview and data collection kiosk system, similar to the first embodiment of Kaplan.

#### New Claims

Claims 71-82 have been added to add dependent claims that include limitations similar to those discussed above, but dependent from claims that do not recite those limitations. For example, claim 71 recites the caching feature of the present invention and depends from claim 62 which recites that the recording is fixed in a medium owned by the user. Thus, it is submitted that claims 71-82 add distinguishing limitations to the claims from which they depend, as discussed above.

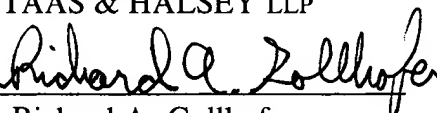
#### Summary

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 2-82 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited. If any fees are required in connection with the filing of this Amendment, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

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